

REMARKS

Applicants respectfully request reconsideration of this U.S. Patent Application. No claims have been amended, added, cancelled, or withdrawn in this response. Thus, claims 1-5 and 7-28 are pending.

Claim Rejections - 35 U.S.C. § 103

Claims 1-3, 12-13, 16-19, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,937,863 issued to Robert, et al. (*Robert*) in view of U.S. Patent No. 5,911,045 issued to Leyba et al. (*Leyba*). For at least the reasons set forth below, the Applicant submits that claims 1-3, 12-13, 16-19, and 21 are not rendered obvious by *Robert* in view of *Leyba*.

The Manual of Patent Examining Procedure ("MPEP"), in § 706.02(j), states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Thus, the MPEP and applicable case law require that the Office action establish that a combination of references teach or suggest **all of the claim limitations** of rejected claims to sustain an obviousness rejection under 35 U.S.C. § 103. As shown below, Applicants respectfully submit that the Office action does not establish a *prima facie* case of obviousness.

Independent claim 1 recites the following:

an electronic asset lending library database containing **a plurality of user accounts** and at least one license for an electronic asset assigned by a user having one of the plurality of user accounts;

an account manager to maintain the user accounts;

an asset manager to maintain each license for an electronic asset assigned by a user having one of the plurality of user accounts, wherein each license includes one or more license restrictions set by the user that assigned the electronic asset; and

a loan manager to **control the assignment** of the license for the electronic asset to another user **having another one of the plurality of user accounts** according to the license restrictions set by the user that assigned the electronic asset.

Independent claims 12 and 16 similarly recite **“a plurality of user accounts”** and **“control[ing] the assignment of [a] license ... to another user having another one of the plurality of user accounts.”**

Regarding the claim limitations directed to, **“a plurality of user accounts”** and **“control[ing] the assignment of [a] license ... to another user having another one of the plurality of user accounts,”** the Office action directs the Applicant’s attention to figure 1, item 10 of *Robert*. Regarding figure 1, item 10 *Robert* states:

In particular, the license management facility 10 then determines whether the usage of the licensed program is permitted under usage limitations. In that operation, the license management facility **obtains the number of license units remaining**, which indicates usage of the licensed program 14 not including the usage requested by the user ... The license management facility 10 then **compares the number of license units which would be allocated for use of the licensed program 14 ... and the number of remaining license units to determine whether sufficient license units remain to permit usage of the licensed program 14.** (Column 4, lines 11-16, emphasis added).

Thus, *Robert* discloses a software licensing management system directed to regulating the use of software in accordance with the terms of an associated license. See column 1, lines 64-68. Specifically, *Robert* addresses the need to regulate the relationship between the *cost* of a license and the *use* of associated software. See column 1, lines 45-57. In order to manage the cost

versus use relationship, *Robert* discloses that a license is granted based on whether “a license usage allocation value” exceeds “a license unit value.” See column 2, lines 15-25. A “license unit value” is a measure of the total value of a license associated with a software program. In contrast, “a license usage allocation value” is a measure of the amount of cumulative use of the software. Thus, as the “license usage allocation value” approaches the “license unit value,” a software program may no longer be licensed. Importantly, the system disclosed in *Robert* is directed to maintaining a plurality of tables with “usage allocation values” and “license unit values” for a number of software programs.

Applicant respectfully submits, however, that *Robert* does not teach or suggest “a **plurality of user accounts**,” as recited in claims 1, 12, and 16. As shown in FIG. 1 and FIG. 2, the license management facility merely accesses a license database (e.g., license database 11). FIG. 2 shows that the entries in the license database pertain to characteristics of a particular copy of a software program. Because *Robert* does not teach or suggest “a **plurality of user accounts**,” Applicant respectfully submits that *Robert* cannot disclose “control[ing] the assignment of [a] license ... by another user having another **one of the plurality of user accounts**,” as recited in claims 1, 12, and 16. Thus, Applicant respectfully submits that *Robert* does not anticipate claims 1, 12, 16, and 22 for at least the reason that *Robert* does not disclose “control[ing] the assignment of [a] license ... by another user having another **one of the plurality of user accounts**.”

Leyba is cited as teaching “a plurality of users being registered over a network to share information.” Whether or not *Leyba* discloses the limitations cited by the Office action, it does not teach or suggest “a **plurality of user accounts**” and “control[ing] the assignment of [a] license ... to another user having another **one of the plurality of user accounts**,” as recited in claims 1, 12, and 16. *Leyba* merely discloses that “attendee[s]” to a virtual conference register

with the virtual environment. See, for example, column 3, lines 39-47. User accounts are not mentioned and “control[ling] the assignment of [a] license ... to another user having another **ne of the plurality of user accounts**” is not taught or suggested by the reference. Therefore, *Leyba* cannot correct the deficiencies of *Robert*.

To establish *prima facie* obviousness the Office action must show that there is some motivation, suggestion or teaching of the desirability of modifying the reference in the manner proposed by the Office action. See *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000).

“Obviousness can only be established where ... there is some teaching, suggestion, or motivation, to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” See MPEP § 2143.01. The Office action does not cite an explicit motivation to combine and the Applicant respectfully submits that neither *Robert* nor *Leyba* provide an explicit motivation to combine the references.

The Applicant further submits that there is no implicit motivation to combine *Robert* and *Leyba*. As shown above, *Robert* is directed to a license management scheme based, at least in part, on the relationship between the *cost* of a license and the *use* of associated software. In contrast, *Leyba* is directed to a virtual reality environment in which “attendee[s]” to a virtual conference register with the virtual environment. Since *Robert* and *Leyba* provide distinct solutions to different problems, the Applicant respectfully submits there is not implied motivation to combine the references.

In summary, the Applicant respectfully submits that the Office action does not establish a *prima facie* case of obviousness against claims 1, 12, and 16 based on the cited passages of *Robert* in view of *Leyba*. Specifically, neither *Robert* nor *Leyba* teach or suggest “**a plurality of user accounts**” and “control[ling] the assignment of [a] license ... to another user having another **one of the plurality of user accounts**,” as recited in claims 1, 12, and 16. Since neither *Robert*

nor *Leyba* teach or suggest the above-cited claim limitations, no combination of *Robert* and *Leyba* teaches or suggests the invention as recited in claims 1, 12, and 16. Also, the Applicant respectfully submits that the Office action fails to show that there is some motivation, suggestion or teaching of the desirability of combining the references in the manner proposed by the Office action. For at least the above-stated reasons, the Applicant respectfully submits that the Office action does not establish a *prima facie* case of obviousness.

Claims 2-3 depend from claim 1. Claim 13 depends from claim 12. Claims 17-19 and 21 depend from claim 16. Because dependent claims include the limitations of the claims from which they depend, the Applicant submits that claims 2-3, 13, 17-19, and 21 are not rendered obvious by *Robert* in view of *Leyba*, for at least the reasons stated above.

Claims 22-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,745,879 issued to Wyman, et al. (*Wyman*) in view of *Leyba*. For at least the reasons set forth below, the Applicant submits that claims 22-26 are not rendered obvious by *Robert* in view of *Leyba*.

Independent claim 22, in part, recites:

managing a plurality of user accounts;

generating a license and associated license restrictions for an electronic asset on a lending library server, **the electronic asset assigned by a user having one of the plurality of user accounts;**

displaying to **an assignee having another one of the plurality of user accounts** the license and associated license restrictions on a lending library client ...

The Office action acknowledges that *Wyman* does not teach or suggest “a plurality of user accounts,” as recited in claim 22. Regarding the claim limitations directed to “a plurality of user accounts,” the Office action directs the Applicant’s attention to column 1, lines 50-67 of *Leyba*, wherein *Leyba* states:

...a plurality of users are **registered** over a network to share information. A three dimensional representation of information to be shared over the network is placed into a shared area of a virtual reality environment. The information is then transferred to all registered users. (Emphasis added).

Leyba further states:

A user ... **registers as an attendee to the virtual environment**... (See column 3, lines 39-42. Emphasis added).

Thus, *Leyba* merely discloses that one or more participants in a virtual environment (e.g., a virtual conference) register as attendees. *Leyba* does not, however, mention creating, maintaining, or managing a user account. There is, for example, nothing in *Leyba* to suggest that user information is maintained after the virtual conference session ends. Since *Leyba* does not teach or suggest "a plurality of user accounts," the Applicant respectfully submits *Leyba* cannot teach or suggest "**managing** a plurality of user accounts," as recited in claim 22.

In summary, the Applicant respectfully submits that the Office action does not establish a *prima facie* case of obviousness against claim 22 based on the cited passages of *Wyman* in view of *Leyba*. Specifically, neither *Wyman* nor *Leyba* teach or suggest "**managing a plurality of user accounts**," as recited in claim 22. Since neither *Wyman* nor *Leyba* teach or suggest the above-cited claim limitations, no combination of *Wyman* and *Leyba* teaches or suggests the invention as recited in claim 22.

Claims 23-26 depend from claim 22. Because dependent claims include the limitations of the claims from which they depend, the Applicant submits that claims 23-26 are not rendered obvious by *Wyman* in view of *Leyba*, for at least the reasons stated above.

Dependent claims 4-5, 7-11, 14-15, 20, and 27-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Robert* in view of U.S. Patent No. 6,892,900 issued to Ginter, et al. (*Ginter*), in further view of *Leyba* and *Wyman*. Claims 4, 5, 7-11, and 27-28 depend, either directly or indirectly, from claim 1 and include the limitations of claim 1. Claims 14 and 15

depend, either directly or indirectly, from claim 12 and include the limitations of claim 12.

Claim 20 depends, indirectly, from claim 16 and includes the limitations of claim 16. For at least the reasons set forth below, the Applicant submits that dependent claims 4-5, 7-11, 14-15, 20, and 27-28 are not rendered obvious by *Robert*, *Ginter*, *Leyba*, and *Wyman*.

As discussed above, claims 1, 12, and 16 recite “**a plurality of user accounts**” and “control[ling] the assignment of [a] license ... to another user having another **one of the plurality of user accounts**.” Also, as shown above, *Robert*, *Leyba*, and *Wyman*, neither individually nor in combination teach or suggest “**a plurality of user accounts**” and “control[ling] the assignment of [a] license ... to another user having another **one of the plurality of user accounts**,” as recited in claims 1, 12, and 16.

Ginter is cited as teaching “an Access Control List (ACL) ... for the purpose of providing full control over pre-defined and user-defined application events.” Whether or not *Ginter* discloses an ACL, it does not teach or suggest “**a plurality of user accounts**” and “control[ling] the assignment of [a] license ... to another user having another **one of the plurality of user accounts**,” as recited in claims 1, 12, and 16. *Ginter*, therefore, does not cure the deficiencies of *Robert*, *Leyba*, and *Wyman*. As stated above, dependent claims 4-5, 7-11, 14-15, 20, and 27-28 depend, either directly or indirectly from independent claims that include the limitations of “**a plurality of user accounts**” and “control[ling] the assignment of [a] license ... to another user having another **one of the plurality of user accounts**.” For at least the reason that *Robert*, *Ginter*, *leyba*, and *Wyman*, either alone or in combination, fail to teach or suggest these claims limitation, the Applicant respectfully submits that the Office action fails to provide a *prima facie* case of obviousness.

Conclusion

In view of the remarks set forth above, Applicants submit that claims 1-5 and 7-28 are in condition for allowance and such action is respectfully solicited. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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